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Atty Docket No. 28265-PA  
PTO FAX NO.: 1-571-273-8300

Attn: Mr. Steven L. Ashburn

CERTIFICATION OF FACSIMILE TRANSMISSION

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Dated: September 21, 2005

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PTO/SB/21 (09-04)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/687,769	
	Filing Date	October 13, 2000	
	First Named Inventor	Steven A. Weiss	
	Art Unit	3714	
	Examiner Name	Steven Ashburn	
Total Number of Pages in This Submission	21	Attorney Docket Number	28265-pa

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm Name	Weintraub Genshlea Chediak
Signature	Bernhard Kreten
Printed name	Bernhard Kreten
Date	September 21, 2005
Reg. No.	27,037

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:	
Signature	Bernhard Kreten
Typed or printed name	Bernhard Kreten
Date	September 21, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4318).**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

**Complete if Known**

Application Number	09/687,769
Filing Date	October 13, 2000
First Named Inventor	Steven A. Weiss
Examiner Name	Steven Ashburn
Art Unit	3714
Attorney Docket No.	28265-pa

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number 501176 Deposit Account Name: Weintraub Genshlea et al.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$)

- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

500.00

**SUBMITTED BY**

Signature	<u>Bernhard Kreten</u>	Registration No. (Attorney/Agent)	<u>27,037</u>	Telephone	<u>916-558-6100</u>
Name (Print/Type)	<u>Bernhard Kreten</u>	Date	<u>September 21, 2005</u>		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Steven A. Weiss	)	
		)	
Serial No.:	09/687,769	)	Art Unit: 3714
		)	Examiner: Steven Ashburn
Filed:	October 13, 2000	)	
		)	
For:	Gaming Award Notice System	)	
	and Method	)	
		)	

September 21, 2005  
Sacramento, California 95814

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S BRIEF (37 CFR § 41.37)**

This brief is filed in support of the Notice of Appeal filed on July 21, 2005, appealing the Examiner's decision rejecting claims 1-15, which was the second rejection of these claims.

09/23/2005 CNGUYEN 00000094 501176 09687769

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**REAL PARTY IN INTEREST**

The real parties in interest in this appeal are the appellant named in the caption of the brief and Casino Data Systems as assignee.

**RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

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**STATUS OF CLAIMS**

**A. TOTAL NUMBER OF CLAIMS IN APPLICATION - Fifteen (15)**

Claims in the application: 1-15.

**B. STATUS OF ALL THE CLAIMS**

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1-15.
4. Claims allowed: None.
5. Claims rejected: 1-15.

**C. CLAIMS ON APPEAL**

The claims on appeal are: 1-15.

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**STATUS OF AMENDMENTS**

No amendments were filed subsequent to the rejection mailed on January 25, 2005.



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**SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 is directed to a method for informing prospective and existing patrons of a gaming establishment about gaming activities involving wagers currently or prospectively in place, the steps including: posting on a wide area network, information concerning a plurality of specific gaming devices located at a site of the gaming establishment; posting on the wide area network information on potential awards, promotions and contests available through gaming; displaying procedures correlating specific gaming device use at the site to attain the awards, promotions and contests; and allowing a prospective player access from a remote location to search as a function of game type, award kind, or individual player status. Spec., pp. 5 and 6; p. 7, l. 20 - p. 8, l. 4; and p. 11, l. 13 - p. 12, l. 16.

Independent claim 7 is directed to a method for informing prospective and existing patrons of a gaming establishment, the steps including: posting on a wide area network information on potential awards, promotions and contests available only at the gaming establishment through wagering on specific gaming devices; allowing a prospective player access from a remote location to search as a function of game type, award kind, or individual player status; and updating the awards, contests, and promotions as they have been changed or previously awarded through wagering. Spec., p. 8, ll. 5-9 and p. 11, l. 6 - p. 12, l. 16.

Independent claim 10 is directed to a gaming system, comprising, in combination: means for displaying awards, contests, and promotions available at a gaming establishment through wagering on a wide area network; means for acquiring the awards, contests and promotions at the establishment through wagering using specific gaming devices; means for replacing the acquired contests, awards and promotions with new ones; and means for allowing a prospective or existing patron to access from a remote location information as a function of game type, award kind, or player status. Spec., p. 8, ll. 10-14 and p. 11, l. 13 - p. 12, l. 16.

Claim 11 depends from claim 10 and further includes means to allow play at a player's remote site. Spec., p. 12 - p. 13, l. 5.

Claim 12 depends from claim 11 and further includes means to award the player as a result of said play. Spec., p. 12 - p. 13, l. 5.

Claim 13 depends on claim 12 and further includes transport means to deliver said award to a player designated locale. Spec., p. 12 - p. 13, l. 5.

Claim 14 depends on claim 13 and further defines the delivery means as a digital voucher. Spec., p. 12 - p. 13, l. 5.

Claim 15 depends on claim 13 and further includes means for displaying said rewards, contests and promotions in the casino on a gaming machine. Spec., p. 16, ll. 16-21.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1, 7, and 10 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

2. Claims 1, 7, 8, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney (U.S. patent no. 6,381,583 B1) in view of "Casino Aztar," Evansville, Indiana.

3. Claims 2, 6, 9, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Casino Aztar, in further view of Letovsky et al. (U.S. patent application publication 2002/0147047 A1).

4. Claims 3, 4, 9, 11, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Casino Aztar and Letovsky et al. in further view of Golden et al. (U.S. patent no. 5,761,648).

## ARGUMENT

### **I. The Rejections Under 35 U.S.C. Section 101**

The Examiner has rejected claims 1, 7, and 10 under 35 U.S.C. section 101 as non-statutory subject matter. The Examiner contends that these claims are non-statutory because they are not within the technological arts and do not produce a useful, concrete, and tangible result, but, rather, are directed to an abstract idea.

According to the Supreme Court in *Diamond v. Diehr*, 450 U.S. 175, 187 (1981), computer-related inventions are patentable subject matter. "A claim drawn to subject matter otherwise statutory does not become non-statutory simply because it uses a mathematical formula, computer program or digital computer." See also *In re Alappat*, 33 F.3d 1526, 1542-3 (Fed. Cir. 1994), in which the Court of Appeals for the Federal Circuit stated that the Supreme Court requires an expansive reading of statutory subject matter under section 101. There, the court held that although certain mathematical subject matter on its own may constitute an abstract idea which is not patentable because it is not useful, this is not the case once the subject matter is reduced to a practical application. *Id.* at 1543 and footnote 18. In *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999), the court confirmed that an algorithm applied in a useful way is patentable subject matter.

Claims 1 and 7 are method claims. The claimed method is a method for providing information to patrons of a gaming establishment by posting the information on a wide area network so that the patrons can access and search the information from a remote location. The information includes awards, promotions, and contests available through gaming at the gaming establishment, and the use of certain specific gaming devices to obtain the awards, etc. at the gaming establishment.

These claims are directed to statutory subject matter. The method, which requires posting information on a wide area network and utilizes computer software, is certainly within the technological arts (rather than the social sciences). See *Diamond v. Diehr, supra*. These claims are not directed to mathematical subject matter on its own, but include a practical application as required by *In re Alappat*. The invention physically displays information on a wide area network which pertains to specific gaming devices physically located at the site of the gaming establishment. The wide area network is used by patrons to search the information by game type, award type, or the patron's own status, to help them decide which gaming device they want to play. This is not an abstract idea or "disembodied concept or truth." See *At&T Corp, supra*, at *id*. Clearly, the claimed invention produces a useful, concrete, and tangible result.

Claim 10 is directed to a gaming system which includes means for physically displaying on a wide area network information pertaining to awards, contests, and promotions that are physically available at a gaming establishment through wagering,

means for acquiring the awards, etc. through specific gaming devices located at the gaming establishment, and means for allowing patrons to access the information from a remote location.

This claim is also directed to statutory subject matter. As with claims 1 and 7, claim 10 provides information to patrons who use the information to make decisions about which gaming devices at the establishment to play. This is clearly not the manipulation of an abstract idea. The result is, as with the method claims, concrete and tangible.

## II. The Rejections Under 35 U.S.C. Section 103(a)

The Examiner's rejection under section 103 is defective because a *prima facie* case of obviousness has not been established.

In rejecting claims under section 103, the Examiner has the burden of making a *prima facie* case of obviousness. First, the Examiner must rely on authenticatable references whose effective dates predate the date the claimed invention was made. Second, the Examiner must demonstrate some teaching, suggestion, or incentive to support the combination. If the prior art does not contain such a teaching, then the Examiner is impermissibly relying on hindsight. *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566,1570 (Fed. Cir. 1996).

### A. The References Cited by the Examiner

Two of the references cited by the Examiner are not proper references because they do not predate Appellant's filing date. The filing date of Appellant's application is October 13, 2000.

Letovsky et al., United States patent application publication no. 2002/0147047 A1 was filed on April 8, 2002 and claims priority to a provisional application filed on November 1, 2000. Thus, Letovsky's effective date is, at the earliest, November 1, 2000, which is after Appellant's filing date of October 13, 2000. Therefore, Letovsky is not a proper reference and may not be cited by the Examiner.

The "Casino Aztar" document cited by the Examiner is not a proper reference. First, the document is not a printout from a website for Casino Aztar at all, but a series of pages printed from a website entitled "web.archive.org." This is shown by the lower left line on the first page of the document. The web.archive.org website purportedly offers a service called "The Way Back Machine." This service states that a user can search for a website to locate web pages that were apparently displayed on certain dates. There is no evidence, however, of the authenticity of the searched pages or of the accuracy of the dates, and no way to verify any of that information.

Second, the document is not dated 1999 as the Examiner claims. The copyright notice on the first page is 1999, but the pages themselves appear to have been obtained

from the web.archive.org website by searching multiple different dates. There is no reliable evidence of the date of the information shown on the pages.

Third, the document provided by the Examiner is a hodge-podge of pages from the web.archive.org website. It is not a single document that ever actually existed. It cannot serve as a proper reference under section 103.

**B. Kenney in View of Casino Aztar**

The Examiner has rejected claims 1, 7, 8, and 10 under section 103(a) over Kenney in view of Casino Aztar. The rejection is improper for three reasons.

First, as stated above, Casino Aztar is not an authenticable document that can constitute a reference. Thus, it cannot form the basis of a section 103 rejection.

Second, even if the Casino Aztar document is deemed to be a proper reference, neither Kenney nor Casino Aztar discloses all of the elements of these claims. Kenney discloses an electronic virtual shopping method that is intended to allow customers to avoid physically shopping at the store or to reduce the time spent actually shopping. Kenney, column 4, lines 28-40. Appellant's claims require a wide area network offered to gaming establishment patrons to plan their trip to the gaming establishment in advance. Patrons can search the wide area network, focusing on the particular gaming devices available at the establishment, the particular awards, etc. available at particular gaming devices, and the individual patron's own status as an ongoing player at that establishment.



Neither Kenney nor Casino Aztar discloses any kind of search activity directed to the individual's own status.

Third, neither Kenney nor Casino Aztar teaches a motivation or suggestion to combine the two references. Kenney discloses a method for virtual shopping; it contains no mention of casino gaming. It is improper for the Examiner to use Applicant's claims as a road map to select components from the prior art to create the claimed invention. See Chisum, Donald S., *Chisum on Patents*, §5.03[2][c] (Lexis 2003), and cases cited therein. This would be impermissible hindsight. Accordingly, claims 1, 7, 8, and 10 are patentable over Kenney in view of Casino Aztar.

**C. Kenney in View of Casino Aztar in View of Letovsky**

The Examiner has rejected claims 2, 6, 9, 11, and 12 under section 103(a) over Kenney in view of Casino Aztar in further view of Letovsky. As set forth above, however, Letovsky is not a proper reference as its effective date of November 1, 2000 is after Appellant's filing date of October 13, 2000. Accordingly, the rejection is improper. Claims 2, 6, 9, 11, and 12 are patentable over Kenney in view of Casino Aztar and in further view of Letovsky.

**D. Kenney in View of Casino Aztar and Letovsky in Further View of Golden**

The Examiner has rejected claims 3, 4, 9, 11, and 13-15 under section 103(a) over Kenney in view of Casino Aztar and Letovsky and in further view of Golden.

As set forth above, however, Letovsky is not a proper reference as its effective date is after Appellant's filing date. Accordingly, the rejection is improper. Claims 3, 4, 9, 11, and 13-15 are patentable over Kenney in view of Casino Aztar and Letovsky in further view of Golden.

### III. Conclusion

In view of the foregoing, it is respectfully requested that the Examiner's rejections be vacated and reversed and this case be passed to issue.

Date: September 21, 2005

Respectfully submitted,

By: Bernhard Kreten  
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APPENDIX: CLAIMS ON APPEAL

1. A method for informing prospective and existing patrons of a gaming establishment about gaming activities involving wagers currently or prospectively in place, the steps including:

posting on a wide area network, information concerning a plurality of specific gaming devices located at a site of the gaming establishment;

posting on the wide area network information on potential awards, promotions and contests available through gaming;

displaying procedures correlating specific gaming device use at the site to attain the awards, promotions and contests; and

allowing a prospective player access from a remote location to search as a function of game type, award kind, or individual player status.

2. The method of claim 1 including allowing a gaming proposition, hosted by a gaming establishment, to be played on the patron's computer remote from the wide area network's locale, and rewarding success regarding the gaming proposition.

3. The method of claim 2 including rewarding success by a digital voucher.

4. The method of claim 2 including rewarding success by transport of a manifestation commemorating the success by allowing a player to designate a locale.
5. The method of claim 2 including rewarding success by allowing redemption of an award in person at a casino.
6. The method of claim 2 including posting new games on the wide area network.
7. A method for informing prospective and existing patrons of a gaming establishment, the steps including:
  - posting on a wide area network information on potential awards, promotions and contests available only at the gaming establishment through wagering on specific gaming devices;
  - allowing a prospective player access from a remote location to search as a function of game type, award kind, or individual player status;
  - and updating the awards, contests, and promotions as they have been changed or previously awarded through wagering.
8. The method of claim 7 including providing the update on a gaming machine at a casino which is under the aegis of the gaming establishment.

9. The method of claim 7 including allowing play from the remote location for an award at the network.

10. A gaming system, comprising, in combination:

means for displaying awards, contests, and promotions available at a gaming establishment through wagering on a wide area network;

means for acquiring the awards, contests and promotions at the establishment through wagering using specific gaming devices;

means for replacing the acquired contests, awards and promotions with new ones; and

means for allowing a prospective or existing patron to access from a remote location information as a function of game type, award kind, or player status.

11. The system of claim 10 further including means to allow play at a player's remote site.

12. The system of claim 11 further including means to award the player as a result of said play.

13. The system of claim 12 further including transport means to deliver said award to a player designated locale.

14. The system of claim 13 wherein said delivery means is a digital voucher.

15. The system of claim 13 further including means for displaying said rewards, contests and promotions in the casino on a gaming machine.